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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,101	12/11/2000	Benoit Ambrose	10244	3915

7590 12/03/2002
ExxonMobil Chemical Company
Law Technology
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EXAMINER	
VO, HAI	
ART UNIT	PAPER NUMBER

1771
DATE MAILED: 12/03/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

AS10

Office Action Summary

Application No.

09/734,101

Applicant(s)

AMBROISE ET AL.

Examiner

Hai Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minato et al (US 5,468,712) in view of Aurenty et al (US 6,276,273) or Leeds (US 3,877,372) substantially as set forth in Paper no. 8.

Response to Arguments

3. The art rejections over Chang in view of Aurenty or Leeds have been overcome by the present arguments.
4. The art rejections over Minato in view of Aurenty or Leeds have been sustained because of the following reasons. The examiner would like to thank the Attorney for pointing out that it would have been obvious to replace Minato's entire dye-receiving layer with the siliconated surfactant of Aurenty or the silicone glycol copolymer of Leeds, **not to modify** the surface of the dye receiving layer with the siliconated surfactant to improve the resolution of the dye receiving layer for achieving successful printing.

Applicant argues that Aurenty's ink receptive composition or Leeds's is not consisting essentially of a silicon glycol composition because the composition includes solutions of resins in water and organic solvents and energy-curable

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formulations. This is not found persuasive since the claim language "consisting essentially of" simply means that the inclusion of additional materials does not change the novel or basic characteristics of Applicant's invention. ***In re Janakirama-Rao, 137 USPQ 893.*** As long as the solutions of resins in water and organic solvents and energy-curable formulations in Aurenty's ink receptive composition or Leeds's do not materially change the image formation of the Applicant's invention, the combination of Minato and Aurenty/Leeds is sufficient and proper.

*The examiner suggests that Applicant can amend the claims by changing the language "consisting essentially of" to --consisting of-- to overcome the art rejections of Minato in view of Leeds.

Further, the examiner disagrees Aurenty never discloses contacting the surfactant with a dye or ink to form an image. The surfactant from the imaged area does come into contact with an ink. The surfactant from the area of the surface which does not form part of the desired image is removed and the ink receptive composition occludes the surfactant from the imaged area (column 5, lines 21-25). Likewise, it is clearly apparent that some surfactants will come into contact with the ink to form the image. The examiner maintains that both Minato and Aurenty references are analogous art and a person of ordinary skill would be motivated to replace Minato's dye image-receiving layer with Aurenty's surfactant since they both come into contact with an ink to form an image.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

HV
November 26, 2002

A handwritten signature in black ink, appearing to read "Terrel Morris", with a stylized flourish at the end.

TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700